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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,969	03/01/2006	Thomas Ficker	017P34WOUS	7341
30008 7590 01/22/2009 GUDRUN E. HUCKETT DRAUDT SCHUBERTSTR. 15A WUPPERTAL, 42289 GERMANY			EXAMINER OMGBA, ESSAMA	
			ART UNIT 3726	PAPER NUMBER
			MAIL DATE 01/22/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,969	Applicant(s) FICKER ET AL.	
	Examiner Essama Omgba	Art Unit 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/6/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because in line 2, "are into one another" should read --are inserted into one another--. Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities: on page 5, line 23, "shouder" should read --shoulder--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-29 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted prior art (AAPA).

Regarding claims 21 and 29, Applicant, at page 1 of the specification to be known as AAPA, discloses an annular composite workpiece comprised of two hollow cylindrical workpieces made of different materials and roll-formed. Applicant should note that the recitation "roll-formed by axial roll forming" is a product-by-process limitation and as such has not been given any patentable weight. "Even though product-by-

Art Unit: 3726

process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claims 22-28, Applicant should note that Official Notice is taken in that such composite workpieces are conventional in the art.

5. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Timmermans (US Patent 3,859,831).

Timmermans discloses an annular composite workpiece comprised of two hollow cylindrical workpieces *m*, *n* made of different materials and rolled formed by axial roll forming (col. 1, lines 29-41 and fig. 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermans in view of Ficker et al. (DE19526900).

With regards to claim 14, Timmermans discloses a method for producing an annular composite workpiece wherein two hollow cylindrical workpieces m and n of different material are inserted into one another (col. 1, lines 29-31 and fig. 1), and are subsequently axially rolled formed by pressing the two hollow cylindrical workpieces against each other between an outer roll forming tool a and an inner roll forming tool e. Although Timmermans does not disclose pressing the two hollow cylindrical workpieces against each other between two diametrically opposed outer roll forming tools and an inner rolling arbor, however it is known to axially roll form workpieces by pressing the workpieces between two diametrically opposed outer roll forming tools and an inner rolling arbor as attested by Ficker et al., see figures 2 and 9. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have substituted the roll arrangement of Timmermans with the one taught by Ficker et al., in order to improve the quality of the resulting composite workpiece.

Regarding claims 15-18, Applicant should note that method of Timmermans/Ficker et al. could be used for rings or pipes, the rings or pipes being either loosely inserted into each other or having play relative to one another such that they can barely be inserted by hand.

8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timmermans/Ficker et al. as applied to claim 14 above, and further in view of Reverman (US Patent 3,068,563).

Regarding claim 19, Timmermans/Ficker et al. discloses a cold rolling method as shown above except for at least one of the surfaces being coated with a material.

Art Unit: 3726

However Reverman teaches a composite workpiece wherein a coating is provided on an outer surface of the inner member, see column 2, lines 15-18. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have applied a coating to the outer surface of the inner workpiece in the method of Timmermans/Ficker et al., in light of the teachings of Reverman, in order to enhance the bond between the surfaces.

Regarding claim 20, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected whatever material was expedient in the method of Timmermans/Ficker et al./Reverman, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. V. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (571) 272-4532. The examiner can normally be reached on M-F 9-6:30, 1st Friday off.

Art Unit: 3726

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Essama Omgba/
Primary Examiner, Art Unit 3726

eo
January 20, 2009